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In re Application of
CURRID : DECISION ON RENEWED
Application No.: 10/089,587 :
PCT No.: PCT/GB97/03351 : PETITION UNDER
Int. Filing Date: 04 December 1997 :
Priority Date: 04 December 1996 : 37 CFR 1.137(b)
Attorney Docket No.: 232.7548USU :
For: NON-RETURN DEVICE :

This decision is in response to applicant's "Renewed Petition Under 37 CFR 1.137(b)" filed 11 April 2003 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 25 October 2002, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.137(b). Applicant was afforded two months to file any request for reconsideration.

On 11 April 2003, applicant filed the present renewed petition under 37 CFR 1.137(b) accompanied by a request for a four-month extension of time and payment of the appropriate extension of time fee. With the filing of the request for a four-month extension of time and payment of the extension fee, applicant's renewed petition is considered timely filed.

DISCUSSION

As detailed in the decision mailed 25 October 2002, a petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the, "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required). Applicant previously satisfied items (1), (2) and (4).

Applicant's original petition was dismissed in part because eight months elapsed between the discovery that applicant had not entered the national stage in the United States and the filing of applicant's original petition to revive. Applicant was advised to provide a more detailed

explanation of this delay as two years had passed from the deadline for entering the national stage and the 28 July 2001 discussion. The present declaration of Mr. Terence Reddick details that within a week of finding out that a national phase application had not been filed in the United States he instructed that a petition to revive be filed. The declaration further details the subsequent actions leading up to the filing of the petition on 29 March 2002. Applicant has provided a sufficient explanation for the delay.

Applicant's original petition was also dismissed because certain statements in the declaration of Mr. Raymond Doughty appeared to indicate that the decision not to enter the United States national stage in a timely manner was an intentional, business decision altered only after a 28 July 2001 meeting between Mr. Doughty and Mr. Currid. The filed Reddick declaration is unfortunately silent on this issue as it only explains actions taken after Mr. Reddick's 05 November 2001 meeting with Mr. Doughty. Applicant has not provided any further evidence to show that the decision made by Mr. Doughty not to file in the national stage in the United States was anything other than a deliberate action on behalf of the corporation. As stated in the Manual of Patent Examining Procedure (MPEP) section 711.03(c):

An intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken. See *In re Maldaque*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988)

* * * * *

Likewise, a change in circumstances that occurred subsequent to the abandonment of an application does not render "unintentional" the delay resulting from a previously deliberate decision to permit an application to be abandoned. These matters simply confuse the question of whether there was a deliberate decision not to continue the prosecution of an application with why there was a deliberate decision not to continue the prosecution of an application.

As stated in the decision mailed 25 October 2002, before applicant's application can be revived pursuant to 37 CFR 1.137(b) applicant must provide an explanation further detailing the decision-making which resulted in certain national stages being entered in a timely fashion on 04 June 1999 which shows that the lack of timely entry into the United States was truly unintentional and not a calculated business decision.

CONCLUSION

For the reasons stated above, the renewed petition for revival is **DISMISSED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional

petition fee is required.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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